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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/142,452	01/19/1999	OSKAR K. WACK	19866.PCT/FA	2215

30996 7590 10/21/2002

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT	PAPER NUMBER
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1746

31

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

4531

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/142,452	WACK ET AL.	
	Examiner	Art Unit	
	Alexander Markoff	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 48-50, 53, 56-58, 60-64, 68 and 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-50, 53, 56-58, 60-64, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 1/28/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/142,452 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Specification and Formal Matters***

2. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

It is noted that the same requirement was made in the previous Office actions.

It is also noted that the Applicants failed to comply with this requirement.

It is further noted that the applicants filed six amendments and several other communications in response to the last Office actions on the merits.

It is further noted that two of these papers (#23 and #29) comprise attachments which are impossible to read.

The applicants are cordially asked to comply with the examiner's requirements, to avoid unnecessary large number of amendments and to file papers which are recognizable and possible to read to avoid an undue delay of the prosecution of the application.

***Claim Rejections - 35 USC § 112***

3. Claims 56-58, 60-64 and 69 are provides for the use of a cleaning composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 56-58, 60-64 and 69 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

It is noted that the applicants consider the "use" claims be proper for the US practice. See paper #24. It is also noted that the applicants rely on MPEP 706.03(d) in their arguments. It is further noted that the applicants state that this part of MPEP indicates that a use claim is acceptable as long as it recites positive steps and that the applicants state that the newly submitted claims recite positive method steps.

The examiner disagrees:

First, MPEP 706.03(d) does not state that the "use" claims are acceptable for the US patent practice.

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Second, the submitted "use" claims do not recite positive manipulative steps.

Third, all the "use" claims are written using "wherein" which is suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEEP 2106 C.

Fourth, it is noted that the "use" claims are filed in addition to the pending method claims. Accordingly it is clear that the applicants do not consider these claims as method or process claims.

The "use" claims are not treated on the merits.

If the applicants would like to claim a process of the invention they should to submit claims which are proper for the USE patent practice, i.e. the claims which recite positive manipulative steps.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 68, 48-50 and 53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time

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the application was filed, had possession of the claimed invention. The applicants filed a new independent claim 68 which requires the composition to contain water, organic component and molecules having lipophilic and hydrophilic groups.

It is noted that the original disclosure requires the organic component to contain the referenced molecules. Thus, the three component composition of the instant claims is not supported by the original disclosure.

### ***Response to Amendment***

6. The amendment filed 6/24/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See the explanation above.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 50 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 50 is indefinite because it is not clear how can the boiling temperature is able to form an azeotrope.

This claim is also contradict to claim 68, which requires contacting the article with an agitated emulsion, not with the condensed cleaning composition.

Claim 51 is indefinite because it is not clear what is required by "prevails".

### ***Claim Objections***

9. Claim 49 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim not only fails to limit the previous claim, it broadens the subject matter of the previous claim.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 68, 48-50, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 475,596.

EPA 475,596 teaches (entire document, especially columns 4 and 5) a method for cleaning articles by contacting them with a liquid mixture of water with an organic

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compound or with a vapor of the mixture of water and the organic compound to remove contaminants from the article. The vapor is allowed to condense on the article. The mixture forms an azeotrope during the "liquid phase-to-vapor phase transition.

3. Claims 68, 48-50, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/28535.

WO 96/28535 teaches a method for cleaning articles comprising the same steps as claimed utilizing the composition as disclosed. The reference teaches the specifically disclosed chemicals as preferred ones. The references also teaches the use of emulsion.

### ***Response to Arguments***

10. Applicant's arguments filed 6/24/02 have been fully considered but they are not persuasive.

The Applicants arguments are not persuasive for the reasons of the record and the reasons discussed during the personal interview conducted 3/28/02.

It is again noted that the applied references teach the same steps as the claimed method and that the references disclose the same chemical compositions as used by the invention as preferred.

It is further noted that it is impossible to read Appendixes 1 and 3.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday - Friday 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Alexander Markoff  
Primary Examiner  
Art Unit 1746

am  
October 20, 2002

**ALEXANDER MARKOFF  
PRIMARY EXAMINER**